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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/562,551	12/28/2005	Masaaki Shimada	1190-0617PUS1	7873
2292 7590 09/15/2010 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
EXAMINER				
TEKLE, DANIEL T				
ART UNIT		PAPER NUMBER		
2621				
NOTIFICATION DATE		DELIVERY MODE		
09/15/2010		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

### Office Action Summary

**Application No.**

10/562,551

**Applicant(s)**

SHIMADA ET AL.

**Examiner**

DANIEL TEKLE

**Art Unit**

2621

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 June 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 December 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/GS/US)
- \_\_\_\_\_ Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)
- \_\_\_\_\_ Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments with respect to claim 1-21 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Objections***

Claim 10-14 objected to because of the following informalities: The language "recording/reproducing" is considered unclear because it is not evident whether ("recording" and "reproducing") or ("recording" or "reproducing") is being claimed. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. **Claim 1-9** is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
3. The claim recites, *inter alia*, "a tangible portable recording medium" (claim 1 line 1) after close inspection, the Examiner respectfully notes that the disclosure, as a whole, does not specifically identify what may be included as a computer readable storage medium and what is not to be included as a tangible portable recording medium.

4. An Examiner is obliged to give claims their broadest reasonable interpretation consistent with the specification during examination. The broadest reasonable interpretation of a claim drawn to a tangible portable recording medium (also called machine readable medium and other such variations) typically covers forms of non-transitory tangible media and transitory propagating signals *per se* in view of the ordinary and customary meaning of computer readable media, particularly when the specification is silent. See MPEP 2111.01. When the broadest reasonable interpretation of a claim covers a signal, *per se*, the claim must be rejected under 35 U.S.C. § 101 as covering non-statutory subject matter.

5. Therefore, given the silence of the disclosure and the broadest reasonable interpretation, the computer readable storage medium of the claim may include transitory propagating signals. As a result, the claim pertains to non-statutory subject matter.

6. However, the Examiner respectfully submits a claim drawn to such a tangible portable recording medium that covers both transitory and non-transitory embodiments may be amended to narrow the claim to cover only statutory embodiments to avoid a rejection under 35 U.S.C. § 101 by adding the limitation "non-transitory" to the claim. Such an amendment would typically not raise the issue of new matter, even when the specification is silent because the broadest reasonable interpretation relies on the ordinary and customary meaning that includes signals per se. For additional information, please see the Patents' Official Gazette notice published February 23, 2010 (1351 OG 212).

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 1-8 and 10-21 rejected under 35 U.S.C. 102(e) as being anticipated by Yuasa et al. (US 2002/0184457).

**Regarding Claim 1:** Yuasa et al. discloses a tangible portable recording medium on which information is digitally recorded to be read and processed by a processor-based apparatus, said *portable recording medium being removable from processor-based apparatus without powering off* **(these limitation has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone)** said processor-based apparatus, said digitally recorded information comprising: reproducible information comprising at least one of encoded compressed video information and encoded compressed audio information **(paragraph 0006)**, which is related to a program to be

broadcasted (**paragraph 0006**), the reproducible information being recorded on the portable recording medium in such manner as to be capable of being decoded, decompressed, and reproduced by the processor-based apparatus (**paragraph 0006**); a reservation set command for recorded on the portable medium in relationship with the reproducible information in such manner as to be capable of being executed by the processor-based apparatus (**paragraph 0130**), while the reproducible information is being reproduced or in response thereto, to set a reservation of video recording and/or audio recording of the program (**fig. 4 element 2001 to 2009**); and program attribute information including at least a broadcast start time of the program (**paragraph 0087 broadcast schedule with start date and time**), which is recorded on the portable recording medium in relationship with the reproducible information and the reservation set command in such manner as to be capable of being used by the processor-based apparatus to set the reservation (**fig. 5 element 2101 to 2104**).

**Regarding Claim 2:** Yuasa et al. discloses a portable recording medium according to claim 1, the digitally recorded information further comprising video information digitally recorded (paragraph 0097 digital demodulation) on the portable medium in such manner as to be capable of being used by the processor-based apparatus during (paragraph 0099) reservation setting to select whether a reservation of video recording and/or audio recording of the program is set or not (paragraph 0023); wherein when a selection is made to set a reservation of video recording and/or audio recording of the program, the reservation set command functions as a command for setting the

reservation of video recording and/or audio recording of the program (**paragraph 0023 and 0025**).

**Regarding Claim 3:** Yuasa et al. discloses a portable recording medium according to claim 1, wherein the reservation set command and the program attribute information are contained in reproduction control information of a video unit (**paragraph 0106 and 0187**); the reproduction control information being placed at a leading end of each video unit (**paragraph 0128 MPEG format**); the video unit comprising an I-picture, data of which is compressed within a frame, a P-picture, data of which is compressed with motion compensation of the I-picture preceding in time, and a B-picture, data of which is compressed with motion compensation of the I-picture or P-picture preceding or following in time (**paragraph 0128 MPEG format**).

**Regarding Claim 4:** Yuasa et al. discloses a portable recording medium according to claim 1, the digitally recorded information further comprising an identification number for identifying the program attribute information (**fig. 4 element 2001-2009**); wherein the reservation set command and the identification number are contained in reproduction control information of a video unit (**paragraph 0106**); the reproduction control information being placed at a leading end of each video unit; the video unit comprising an I-picture, data of which is compressed within a frame, a P-picture, data of which is compressed with motion compensation of the I-picture preceding in time, and a B-picture, data of which is compressed with motion compensation of the I-picture or P-picture preceding or following in time (**paragraph 0128 MPEG format**).

**Regarding Claim 5:** Yuasa et al. discloses a portable recording medium according to claim 1, wherein the reservation set command and the program attribute information are contained in a command table in a management area placed in a lump in the portable recording medium, the command table being referenced after the program ends (**fig. 4 content management information 2000 as a whole description**).

**Regarding Claim 6:** Yuasa et al. discloses a portable recording medium according to claim 1, the digitally recorded information further comprising an identification number for identifying the program attribute information (**fig. 4 content management information 2000 as a whole description**); wherein the reservation set command and the program attribute information are contained in a command table in a management area placed in a lump in the portable recording medium, the command table being referenced after the program ends (**fig. 4 content management information 2000 as a whole description**).

**Regarding Claim 7:** Yuasa et al. discloses a portable recording medium according to claim 1, the digitally recorded information further comprising an identifier indicating whether the portable recording medium holds the reservation set command and the program attribute information or not (**paragraph 0125 and fig. 4**).

**Regarding Claim 8:** Yuasa et al. discloses a portable recording medium according to claim 1, wherein the portable recording medium comprises a reproduction-only area and a recordable area (**paragraph 0145 and 0147**); the reproduction-only area holding the reproducible information, the reservation set command, and the program attribute



information (**paragraph 0145 and 0147**); the recordable area being an area, in which video recording and/or audio recording of the program can be made (**paragraph 0145, 0147 and fig. 3 element 1231, 1270**).

**Regarding Claim 10:** Yuasa et al. discloses a video recording/reproducing apparatus for reproducing data from the reproducible information recorded on the portable recording medium of claim 1; the video recording/reproducing apparatus comprising: at least one processor configured to: obtain the reservation set command of the portable recording medium (**paragraph 0130**) and obtain program attribute information in accordance with the reservation set command and setting a reservation of video recording and/or audio recording in accordance with the program attribute information (**paragraph 0145 and 0147**).

**Regarding Claim 11:** Yuasa et al. discloses a video recording/reproducing apparatus for reproducing data from the reproducible information recorded on the portable recording medium of claim 5, the video recording/reproducing apparatus comprising: at least one processor configured to obtain the reservation set command, with reference to a command table after the program ends (**paragraph 0180 and fig. 10**); set a reservation of video recording and/or audio recording on the basis of the program attribute information in accordance with the reservation set command when a selection is made to set a reservation of video recording and/or audio recording of the program (**paragraph 0152-0153**).

**Regarding Claim 12:** Yuasa et al. discloses a video recording/reproducing apparatus for reproducing data from the reproducible information recorded on the portable recording medium of claim 4, the video recording/reproducing apparatus comprising: at least one processor configured to obtain the reservation set command of the portable recording medium (**paragraph 0152-0153**); and obtain program attribute information corresponding to the identification number in accordance with the reservation set command and set a reservation of video recording and/or audio recording on the basis of the program attribute information (**paragraph 0152-0153**).

**Regarding Claim 13:** Yuasa et al. a video recording/reproducing apparatus for reproducing data from the reproducible information recorded on the portable recording medium of claim 7, the video recording/reproducing apparatus comprising: at least one processor configured to: determine whether a reservation of video recording and/or audio recording in accordance with the reservation set command is set or not, on the basis of an identifier held in the portable recording medium (**fig. 6**); obtain the reservation set command of the portable recording medium in accordance with a result of the determination of whether the reservation is set or not (**fig. 6**); and the program attribute information in accordance with the reservation set command, and set a reservation of video recording and/or audio recording on the basis of the program attribute information (**fig. 6**).

**Regarding Claim 14:** Yuasa et al. discloses a video recording/reproducing apparatus for reproducing data from the reproducible information recorded on the portable recording medium of claim 8, the video recording/reproducing apparatus comprising: at

least one processor configured to: obtain the reservation set command of the portable recording medium (**fig. 6**); and obtain the program attribute information in accordance with the reservation set command, and set a reservation of video recording and/or audio recording in a recordable area on the basis of the program attribute information (**fig. 6**).

**Regarding Claim 15:** Yuasa et al. discloses a video reproducing apparatus for reproducing data from the reproducible information recorded on the portable recording medium of claim 1, the video reproducing apparatus comprising: at least one processor configured to: obtain the reservation set command of the portable recording medium (**fig. 6**); obtain the program attribute information in accordance with the reservation set command (**fig. 6**); and cause the program attribute information to be transmitted from the video reproducing apparatus (**fig. 3 element 1394**).

**Regarding Claim 16:** Yuasa et al. discloses a video recording apparatus comprising: at least one processor configured to: receive the program attribute information transmitted from the video reproducing apparatus of claim 15; set a reservation of video recording and/or audio recording on the basis of the received program attribute information (**fig. 6**); and record the program in accordance with the reservation of video recording and/or audio recording, which has been set (**fig. 11**).

**Regarding Claim 17:** Yuasa et al. discloses a video recording/reproducing apparatus for reproducing data from the reproducible information recorded on the portable recording medium of claim 1, the video recording/reproducing apparatus comprising: at least one processor configured to: reproduce data from the portable recording medium

(**paragraph 0006**); obtain the reservation set command of the portable recording medium (**paragraph 0087-0088**); obtain the program attribute information in accordance with the reservation set command and setting a reservation of video recording and/or audio recording on the basis of the program attribute information (**paragraph 0087-0088**); and record the program in accordance with the reservation of video recording and/or audio recording, which has been set (**paragraph 0087-0088**).

**Regarding Claim 18:** Yuasa et al. discloses a recording/reproducing method of reading and processing data from the information digitally recorded on the portable recording medium of Claim 1, the method comprising the steps of: reading at least part of the reproducible information stored on the portable recording medium related to the program, and reproducing data from the read reproducible information (**paragraph 0087-0088**); obtaining the reservation set command of the portable recording medium (**paragraph 0087-0088**); and obtaining the program attribute information in accordance with the reservation set command and setting a reservation of video recording and/or audio recording on the basis of the program attribute information (**paragraph 0087-0088**).

**Regarding Claim 19:** Yuasa et al. discloses a method of reading and processing data from the information digitally recorded on the portable recording medium of Claim 1, the method comprising the steps of: reading at least part of the reproducible information stored on the portable recording medium related to the program, and reproducing data from the read reproducible information (**paragraph 0145**); obtaining the reservation set command of the portable recording medium (**Fig. 5**); obtaining the

program attribute information in accordance with the reservation set command; and sending the program attribute information (**Fig. 5**).

**Regarding Claim 20:** Yuasa et al. discloses a video recording method comprising the steps of: receiving the program attribute information sent by in accordance with Claim 19 (**Fig. 6**); setting a reservation of video recording and/or audio recording in accordance with the program attribute information, which has been received (**Fig. 6**); and recording the program in accordance with the reservation of video recording and/or audio recording, which has been set (**Fig. 6**).

**Regarding Claim 21:** Yuasa et al. discloses a portable recording medium according to claim 1, wherein the digitally recorded information further comprises button display video information, which includes information related to the reservation, digitally recorded on the portable medium in such manner as to be capable of being used by the processor-based apparatus for displaying at least one button overlaid on a displayed image which is related to the program to be broadcasted (**paragraph 0155 and 0313**).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 9 rejected under 35 U.S.C. 103(a) as being unpatentable over Yuasa et al. (US 2002/0184457); as applied to claim 1-8 and 11-21 above, and further in view of Mori et al. (US 5,854,873).

**Regarding Claim 9:** Yuasa et al. discloses a portable recording medium according to claim 8, further Yuasa et al. did not disclose, however Mori et al. disclose wherein the portable recording medium is a single-sided dual-layer recording medium comprising a first recording layer and a second recording layer (**column 13 line 66 to column 14 line 16: RS1 and RS2**); the first recording layer comprising the reproduction-only area (**column 14 lines 4-10: It is noted that RS1 or RS2 can read data, since reading required to have a predetermined data stored in**); the second recording layer comprising the recordable area (**column 14 line lines 4-10: Each layer RS1 or RS2 that is not reserve for reproduction only is a recording area**).

It would have been obvious to one ordinary skill in the art at the time of the invention was made to combine Mori et al. invention into Yuasa et al. invention in order to have a larger capacity of optical disc.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL TEKLE whose telephone number is (571)270-1117. The examiner can normally be reached on 7:30am to 5:00pm M-R and 7:30-4:00 Every other Friday..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter-Anthony Pappas can be reached on 571-272-7646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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